



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/563,088

12/30/2005

Takafumi Yoshimura

396.45629X00

8126

20457

7590

01/05/2009

ANTONELLI, TERRY, STOUT & KRAUS, LLP

1300 NORTH SEVENTEENTH STREET

SUITE 1800

ARLINGTON, VA 22209-3873

EXAMINER

KATAKAM, SUDHAKAR

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

01/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/563,088

**Applicant(s)**

YOSHIMURA ET AL.

**Examiner**

Sudhakar Katakam

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5, 7-11, 13-16, 18 and 19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 4, 5, 7-11, 13-16, 18 and 19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the application***

1. Receipt of Applicant's request for continued examination filed on 6<sup>th</sup> Oct 2008 is acknowledged.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 6<sup>th</sup> Oct 2008 has been entered.

2. Applicants' amended the claims 1, 4-5, 7-11 and 18.
3. Applicants' cancelled the claims 2-3, 6, 12, 17 and 20.
4. Claims 1, 4-5, 7-11, 13-16 and 18-19 are examined on the merits in this office action.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 4-5, 7-11, 13-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Igari et al** (JP2003012597), in view of **Aizawa et al** (JP2003089673) and **Singh et al** (US 5892138).

**Igari et al** teach a process of iodination of methylbenzoic acid with iodinating agents in the presence of acid catalysts in solvents [see claim 1 and work examples]. The iodinating agents are iodine, periodic acid, or periodate [see 0007]. **Igari et al also** teach that the reaction is performed by carrying out heating churning, since iodine has sublimability, it is desirable to make it react, while flowing back of a solvent protects a deposit [see 0014]. At this reaction, although a conversion ratio is high, since the solubility of a product is comparatively high, there are many remains to a solvent, it is possible enough to raise a yield by recycling of reaction mother liquor, and since it is the purpose of increase in efficiency, recycling is recommended [0015].

The differences between the instant claims and **Igari et al** are as follows:

- (i) **Igari et al** does not teach applicants H-beta-form zeolite, which has Si/Al;
- (ii) **Igari et al** does not teach explicitly the purification steps include sublimation, distillation, crystallization or combination of two or more of these;

With regard to (i) and (ii) of above, **Singh et al** teach use of zeolite catalyst in presence of aliphatic carboxylic acid, such as H-beta type zeolite, in the process for the preparation of halocumenes, which contains  $\text{SiO}_2/\text{Al}_2\text{O}_3$  molar ratio from 2-10 and an

alkali or alkaline earth metal in the catalyst [col. 2, lines 13-55]. **Singh et al** also teach a recyclable zeolite can be used [col. 7, lines 46].

With regard to (ii) of above, **Aizawa et al** teach recrystallization of the product in a process of separation and purification of 5-iodo-2-methylbenzoic acid [section 12, and section 18].

The claims would have been obvious because, a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product, not of innovation, but of ordinary skill and common sense.

The claim would have been obvious because the design incentives or market forces provided a reason to make an adaptation, and the invention resulted from application of the prior knowledge in a predictable manner.

All the claimed elements were known in the prior art and one skilled person in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to have yielded predictable results to one of ordinary skill in the art at the time of the invention.

The Supreme Court in KSR noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then the resulting invention would have been obvious because one of ordinary skill could not have been expected to achieve it.

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time of the invention, to combine the teachings of above cited references, with a reasonable expectation that the combined chemical process would be streamlined and result in cost reduction. The expected result would be the efficient production of 5-iodo-2-methylbenzoic acid for the chemical industry.

Some limitations of the dependent claims may not be expressly disclosed in the cited references, such as temperature, ratios, purification and recovery of the zeolite. However, these limitations, at the time of the invention, one of ordinary skilled person in the art would through routine and normal experimentation determine the optimization of these limitations to provide the best effective variable depending on the results desired. Changing such parameters is prima facie obvious because an ordinary artisan would be motivated to optimize a process. Merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233 (C.C.P.A. 1955).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 4-5, 7-11, 13-16 and 18-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending U.S. Applications 10/545,005.

Although the conflicting claims are not identical, they are not patentably distinct from each other because, notwithstanding the fact that the conflicting claims require additional elements and steps, the conflicting claims recite. The instant process for preparing 5-iodo-2-methylbenzoic acid, with such particularity, that the instant process would have been *prima facie* obvious.

It would have been a *prima facie* obvious to a person of ordinary skill in the art, at the time the present invention was made, to used the combination of the copending applications and to expect the 5-iodo-2-methylbenzoic acid. The difference, however, does not constitute a patentable distinct, because the claims in the present invention simply fall within the scope of copending application, since the similar reactants and conditions. Hence the instant claims overlap with the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not been patented yet.

***Response to Arguments***

10. Applicant's arguments filed on 6<sup>th</sup> Oct 2008 have been fully considered but they are not persuasive.

Applicants' remarks in connection with the previous rejection have been addressed in the above rejection.

***Conclusion***

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a



Art Unit: 1621

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sudhakar Katakam/

Examiner, Art Unit 1621

/Jafar Parsa/

Primary Examiner, Art Unit 1621